REMARKS/ARGUMENTS

Claims 2-9, 12-17 and 19 remain pending herein. Claims 10 and 18 are canceled hereby.

Claims 3-5, 10 and 12-18 were rejected under 35 U.S.C.§102(a) over Japanese 2000-149886 (JP '886).

Attached hereto are three Declarations, each having been signed by one of the three present inventors.

As noted in the Amendment filed July 9, 2003, and as stated in the Declarations attached thereto, the two inventors in JP '886, Teruhisa Kurokawa and Kenshin Kitoh, are two of the three inventors named in the present application. As stated in the three Declarations attached hereto, Teruhisa Kurokawa and Kenshin Kitoh are the co-inventors of the subject matter recited in original claims 2, 10, 18 and 19 of the present application. As noted above, the subject matter of claim 10 has been incorporated into claim 2, and the subject matter of claim 18 has been incorporated into claim 19. Accordingly, the inventorship for claims 2 and 19, amended as set forth above, is the same as the inventorship in JP '886. As further noted in the Declarations attached hereto, the three inventors in the present application are co-inventors of the subject matter recited in claims 3-9 and 12-17 of the present application, and to the extent that JP '886 contains subject matter that the U.S. PTO believes would render obvious any of claims 3-9 and 12-17 of the present application, such subject matter in JP '886 resulted from invention by the three inventors named herein. Accordingly, JP '886 does not constitute prior art relative to claims 3-9 and 12-17 of the present application under any section of 35 U.S.C.§102 (including 35 U.S.C.§102(a)), which requires that in the case of a printed publication, that the invention be described in a printed publication *before the invention thereof by the applicant* -- since JP '886 describes the invention of the present inventors, the publication of JP '886 did not occur before the invention by the present inventors.

In view of the above, it is respectfully requested that the U.S. Patent and Trademark Office reconsider and withdraw this rejection.

Claims 2-5, 12, 13 and 19 were rejected under 35 U.S.C.§103(a) over U.S. Patent No. 5,462,820 (Tanaka '820) in view of U.S. Patent No. 3,713,896 (Feldhake '896).

The Office Action contains an acknowledgment that Tanaka '820 does not disclose that the ethylene-propylene rubber has a surface hardness of from 30 (durometer A) to 60 (durometer D), as recited in claims 2 and 19. The Office Action contains an assertion that

Feldhake '896 discloses that a particular cured epoxy-polyamide resin is a visco-elastic solid having physical properties similar to ordinary rubber (durometer hardness of about 40 to 70).

Ethylene-propylene rubber exhibits hardness within a wide range. Attached are copies of three references which disclose respective ranges for the hardnesses of the ethylene-propylene rubber employed in each instance. Japanese 7-28,229 discloses hardness within a range of from A10 to A65 (see page 4, paragraph [0029]). Japanese 6-332,194 discloses hardness within a range of from A25 to A50 (see page 6, paragraph [0040]). Japanese 5-237,436 discloses hardness within a range of from A30 to D80 (see page 2, paragraphs [0006] and [0007]).

In view of the wide range of hardness which ethylene-propylene rubber can exhibit, disclosure in Feldhake '896 of an epoxy-polyamide resin having durometer hardness of about 40 to 70 would not cause one of skill in the art to interpret disclosure of the ethylene-propylene rubber gasket in Tanaka '820 to mean that the hardness of the ethylene-propylene rubber gasket of Tanaka '820 would inherently have a surface hardness of from durometer 40 to durometer 70, nor does Feldhake '896 contain any disclosure which would suggest to one of ordinary skill in the art that when constructing an ethylene-propylene rubber gasket according to Tanaka '820, one should select the ethylene-propylene rubber such that the surface hardness thereof should fall within the range that Feldhake '896 discloses is exhibited by epoxy-polyamide resin.

In addition, attached is a copy of a reference describing a standard test method for measuring durometer hardness properties of rubber.

In addition, as noted above, claims 2 and 19 have been amended to incorporate claims 10 and 18, respectively, i.e., to recite that the insulator material has a volume resistivity of at least $10^{10}\,\Omega$-cm.

The September 25, 2003 Office Action contains an acknowledgment that neither Tanaka '820 nor Feldhake '896 discloses a volume resistivity of ethylene-propylene rubber of at least $10^{10}\,\Omega$-cm. Regarding claims 10 and 18, the Office Action contains reference to U.S. Patent No. 5,624,771 (Sano '771), and disclosure therein of sealing an electrolyte cell by applying a sealant such as a plastic gasket having a high electrolyte resistance and electrical insulation characteristics between a cover case 1 acting as a positive terminal and a bottom case 5 acting as a negative terminal. However, Sano '771 does not disclose or suggest any specific values of electrical insulation characteristics, let alone disclosure of an insulating

material having a volume resistivity of at least $10^{10}\Omega$-cm. Accordingly, for this additional reason, claims 2 and 19 are patentable over the prior art relied on in the Office Action.

Accordingly, it is respectfully requested that the U.S. Patent and Trademark Office reconsider and withdraw this rejection.

Claims 10 and 18 were rejected under 35 U.S.C.§103(a) over Tanaka '820 in view of Feldhake '896, further in view of Sano '771. As discussed above, claims 10 and 18 have been canceled, rendering moot this rejection.

Accordingly, it is respectfully requested that the U.S. Patent and Trademark Office reconsider and withdraw this rejection.

Claims 2-9 were rejected under 35 U.S.C.§103(a) over European 771 040 (EP '040) in view of Tanaka '820 and Feldhake '896.

The Office Action contains an acknowledgment that EP '040 fails to disclose or suggest insulators comprising an ethylene-propylene rubber having surface hardness of from 30 (durometer A) to 60 (durometer D). The Office Action contains reference to Tanaka '820 and Feldhake '896 and assertions similar to those discussed above regarding the applicability of Tanaka '820 and Feldhake '896 to the recitation in claim 2 of an insulator comprising ethylene-propylene rubber having a surface hardness as recited in claim 2. Accordingly, it is respectfully noted that the applied combination of references fails to render obvious the subject matter recited in claim 2 for the same reasons discussed above, namely, that disclosure in Feldhake '896 of an epoxy-polyamide resin having durometer hardness of about 40 to 70 would not cause one of skill in the art to interpret disclosure of the ethylene-propylene rubber gasket in Tanaka '820 to mean that the hardness of the ethylene-propylene rubber gasket of Tanaka '820 would inherently have a surface hardness of from durometer 40 to durometer 70, nor does Feldhake '896 contain any disclosure which would suggest one of ordinary skill in the art that when constructing an ethylene-propylene rubber gasket according to Tanaka '820, one should select the ethylene-propylene rubber such that the surface hardness thereof should fall within the range that Feldhake '896 discloses is exhibited by epoxy-polyamide resin.

In addition, the Office Action contains no assertion that any of the applied references disclose or suggest any specific values of electrical insulation characteristics, let alone disclosure of an insulating material having a volume resistivity of at least $10^{10}\Omega$-cm.

Accordingly, it is respectfully requested that the U.S. Patent and Trademark Office reconsider and withdraw this rejection.

Claims 2-8, 12-17 and 19 were rejected under35 U.S.C.§103(a) over U.S. Patent No. 5,571,632 (Teramoto '632) in view of Tanaka '820 and Feldhake '896.

The Office Action contains an acknowledgment that Teramoto '632 fails to disclose or suggest insulators comprising an ethylene-propylene rubber having surface hardness of from 30 (durometer A) to 60 (durometer D). The Office Action again contains reference to Tanaka '820 and Feldhake '896 and assertions similar to those discussed above regarding the applicability of Tanaka '820 and Feldhake '896 to the recitation in claim 2 of an insulator comprising ethylene-propylene rubber having a surface hardness as recited in claim 2. It is respectfully noted that the applied combination of references fails to render obvious the subject matter recited in claims 2 and 19 for the same reasons discussed above, namely, that disclosure in Feldhake '896 of an epoxy-polyamide resin having durometer hardness of about 40 to 70 would not cause one of skill in the art to interpret disclosure of the ethylene-propylene rubber gasket in Tanaka '820 to mean that the hardness of the ethylene-propylene rubber gasket of Tanaka '820 would inherently have a surface hardness of from durometer 40 to durometer 70, nor does Feldhake '896 contain any disclosure which would suggest one of ordinary skill in the art that when constructing an ethylene-propylene rubber gasket according to Tanaka '820, one should select the ethylene-propylene rubber such that the surface hardness thereof should fall within the range that Feldhake '896 discloses is exhibited by epoxy-polyamide resin.

In addition, the Office Action contains no assertion that any of the applied references disclose or suggest any specific values of electrical insulation characteristics, let alone disclosure of an insulating material having a volume resistivity of at least $10^{10}\Omega$-cm.

Accordingly, it is respectfully requested that the U.S. Patent and Trademark Office reconsider and withdraw this rejection.

Claims 2-5, 12, 13 and 19 were rejected under obviousness-type double patenting over claims 1-12 of U.S. Patent No. 6,139,986 (Kurokawa '986) in view of Feldhake '896.

The Office Action contains an acknowledgment that the claims of Kurokawa '986 fail to disclose or suggest insulators comprising an ethylene-propylene rubber having surface hardness of from 30 (durometer A) to 60 (durometer D). The Office Action contains reference to Feldhake '896 and assertions similar to those discussed above regarding the applicability of Feldhake '896 to the recitation in claim 2 of an insulator comprising ethylene-propylene rubber having a surface hardness as recited in claim 2. It is respectfully noted that the applied combination of references fails to render obvious the subject matter recited in

claims 2 and 19 for the same reasons discussed above, namely, that disclosure in Feldhake '896 of an epoxy-polyamide resin having durometer hardness of about 40 to 70 would not cause one of skill in the art to interpret disclosure of the ethylene-propylene heat shrinkage tube in Kurokawa '986 to mean that the hardness of the ethylene-propylene heat shrinkage tube of Kurokawa '986 would inherently have a surface hardness of from durometer 40 to durometer 70, nor does Feldhake '896 contain any disclosure which would suggest one of ordinary skill in the art that when constructing an ethylene-propylene heat shrinkage tube according to Kurokawa '986, one should select the ethylene-propylene rubber such that the surface hardness thereof should fall within the range that Feldhake '896 discloses is exhibited by epoxy-polyamide resin.

In addition, the Office Action contains no assertion that any of the applied references disclose or suggest any specific values of electrical insulation characteristics, let alone disclosure of an insulating material having a volume resistivity of at least $10^{10}\,\Omega$-cm.

Accordingly, it is respectfully requested that the U.S. Patent and Trademark Office reconsider and withdraw this rejection.

Claims 2-10 and 12-19 were rejected under obviousness-type double patenting over claims 1-53 of U.S. Patent Application Serial No. 09/863,108 in view of Feldhake '896.

The Office Action contains an acknowledgment that the claims of U.S. Patent Application Serial No. 09/863,108 fail to disclose or suggest insulators comprising an ethylene-propylene rubber having surface hardness of from 30 (durometer A) to 60 (durometer D). The Office Action contains reference to Feldhake '896 and assertions similar to those discussed above regarding the applicability of Feldhake '896 to the recitation in claim 2 of an insulator comprising ethylene-propylene rubber having a surface hardness as recited in claim 2. Accordingly, it is respectfully noted that the applied combination of references fails to render obvious the subject matter recited in claim 2 for the same reasons discussed above, namely, that disclosure in Feldhake '896 of an epoxy-polyamide resin having durometer hardness of about 40 to 70 would not cause one of skill in the art to interpret disclosure of the ethylene-propylene elastic body in claims 1-53 of U.S. Patent Application Serial No. 09/863,108 to mean that the hardness of an ethylene-propylene elastic body according to one of the selections from the materials recited in claim 13 or claim 22 of U.S. Patent Application Serial No. 09/863,108 would inherently have a surface hardness of from durometer 40 to durometer 70, nor does Feldhake '896 contain any disclosure which would suggest one of ordinary skill in the art that when constructing an ethylene-propylene elastic body according

to one of the selections from the materials recited in claim 13 or claim 22 of U.S. Patent Application Serial No. 09/863,108, one should select the ethylene-propylene rubber such that the surface hardness thereof should fall within the range that Feldhake '896 discloses is exhibited by epoxy-polyamide resin.

Accordingly, it is respectfully requested that the U.S. Patent and Trademark Office reconsider and withdraw this rejection.

Claims 2-5, 12-17 and 19 were rejected under obviousness-type double patenting over claims 1-27 of U.S. Patent Application Serial No. 09/937,943 (the '943 application) in view of Feldhake '896.

The Office Action contains an acknowledgment that '943 application fails to disclose or suggest insulators comprising an ethylene-propylene rubber having surface hardness of from 30 (durometer A) to 60 (durometer D). The Office Action contains reference to Feldhake '896 and assertions similar to those discussed above regarding the applicability of Feldhake '896 to the recitation in claim 2 of an insulator comprising ethylene-propylene rubber having a surface hardness as recited in claim 2. Accordingly, it is respectfully noted that the applied combination of references fails to render obvious the subject matter recited in claim 2 for the same reasons discussed above, namely, that disclosure in Feldhake '896 of an epoxy-polyamide resin having durometer hardness of about 40 to 70 would not cause one of skill in the art to interpret disclosure of the ethylene-propylene elastic body according to one of the selections of materials recited in claim 6 of the '943 application to mean that the hardness of the ethylene-propylene elastic body according to one of the selections of materials recited in claim 6 of the '943 application would inherently have a surface hardness of from durometer 40 to durometer 70, nor does Feldhake '896 contain any disclosure which would suggest one of ordinary skill in the art that when constructing an ethylene-propylene elastic body according to one of the selections of materials recited in claim 6 of the '943 application, one should select the ethylene-propylene rubber such that the surface hardness thereof should fall within the range that Feldhake '896 discloses is exhibited by epoxy-polyamide resin.

In addition, the Office Action contains no assertion that any of the applied references disclose or suggest any specific values of electrical insulation characteristics, let alone disclosure of an insulating material having a volume resistivity of at least $10^{10}\Omega$-cm.

Accordingly, it is respectfully requested that the U.S. Patent and Trademark Office reconsider and withdraw this rejection.

In view of the above, claims 2-9, 12-17 and 19 are in condition for allowance.

If the Examiner believes that contact with Applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicants' attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,

January 26, 2004
Date

Kevin C. Brown
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KCB:jms
Enclosures:
Three (3) Declarations
Four (4) References

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